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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,857	11/28/2000	Koen Weterings	023070-114700US	7630

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EXAMINER	
COLLINS, CYNTHIA E	
ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 08/27/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b> 09/724,857	<b>Applicant(s)</b> WETERINGS ET AL.	
	<b>Examiner</b> Cynthia Collins	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78 and 81-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78 and 81-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

The Amendment filed June 4, 2003, paper no.15, has been entered.

Claims 1-77 and 79-80 are cancelled.

Claim 78 is newly amended.

Claims 81-92 are newly added.

Claims 78 and 81-92 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

***Claim Objections***

Claim 81 is objected to for failing to comply with 37 CFR 1.821(d), in that reference is not made to the sequence "nucleotides -921 to -767 displayed in Figure 2" by use of a sequence identifier preceded by "SEQ ID NO:." in the text of the claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claim 81 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 81 is drawn to a promoter polynucleotide that specifically initiates transcription in plant suspensor cell and/or basal region of a plant embryo, said promoter polynucleotide comprising a promoter control element comprising nucleotides -921 to -767 displayed in Figure 2.

The limitation "a promoter control element comprising nucleotides -921 to -767 displayed in Figure 2" does not find support in the specification as originally filed, and thus constitutes new matter. Applicant asserts at pages 4-5 of the reply filed June 4, 2003 that support for new claim 81 can be found in Figure 2 and at pages 26 and 63 of the specification, and makes reference to a subsequence corresponding to -913 to -767 in Figure 2. While the specification supports a subsequence corresponding to -913 to -767 in Figure 2, claim 81 currently refers to a subsequence corresponding to -921 to -767 in Figure 2.

Claim 78 remains rejected, and newly added claims 81-92 are rejected, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the office action mailed December 3, 2002.

Applicant's arguments filed June 4, 2003, have been fully considered but they are not persuasive.

The claims as amended are drawn to a promoter polynucleotide that specifically initiates transcription in plant suspensor cell and/or basal region of a plant embryo, said promoter

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polynucleotide comprising a promoter control element comprising nucleotides -921 to -767 displayed in Figure 2.

The specification describes a suspensor-specific control element between positions -921 and -662 of Figure 2 (page 62 and Figure 6), as well as three additional promoter fragments that function to drive suspensor specific gene expression, said promoter fragments corresponding to from positions -1524 to -99 of Figure 2, from positions -2064 to -99 of Figure 2, and from positions -913 to -767 of Figure 2 (page 63 and Figure 7), but the specification does not describe a promoter fragment corresponding to nucleotides -921 to -767 displayed in Figure 2 that functions to drive suspensor specific gene expression.

Applicant argues that the prior rejection is moot as all pending claims now depend from claim 81, which is directed to a polynucleotide comprising nucleotides -921 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is exemplified in the specification, at page 63 lines 9-10 and in Figure 7 (reply page 6).

The Examiner maintains that a polynucleotide comprising nucleotides -921 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is not exemplified in the specification at page 63 lines 9-10 and in Figure 7, or elsewhere in the specification. The Examiner notes, however, the exemplification at page 63 lines 9-10 and in Figure 7 of a promoter control element comprising nucleotides -913 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is exemplified. It is suggested that claim 81 be amended to correspond to the promoter control element comprising nucleotides -913 to -767 as displayed in Figure 2, with reference to the appropriate sequence identifier as indicated in the above objection to claim 81, in order to obviate the rejection.

Claim 78 remains rejected, and newly added claims 81-92 are rejected, under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the exemplified isolated polynucleotides disclosed as functioning to promote transcription in suspensor cells and or the basal region of a plant embryo, does not reasonably provide enablement for other polynucleotides that are not disclosed as functioning to promote transcription in suspensor cells and or the basal region of a plant embryo. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims, for the reasons of record set forth in the office action mailed December 3, 2002.

Applicant's arguments filed June 4, 2003, have been fully considered but they are not persuasive.

The claims as amended are drawn to a promoter polynucleotide that specifically initiates transcription in plant suspensor cell and/or basal region of a plant embryo, said promoter polynucleotide comprising a promoter control element comprising nucleotides -921 to -767 displayed in Figure 2.

The specification discloses a suspensor-specific control element determined to be present between positions -921 and -662 of Figure 2 (page 62 and Figure 6), as well as three additional promoter fragments that function to drive suspensor specific gene expression, said promoter fragments corresponding to from positions -1524 to -99 of Figure 2, from positions -2064 to -99 of Figure 2, and from positions -913 to -767 of Figure 2 (page 63 and Figure 7), but the specification does not disclose a promoter fragment corresponding to nucleotides -921 to -767 displayed in Figure 2 that functions to drive suspensor specific gene expression.

Applicant argues that the prior rejection is moot as all pending claims now depend from claim 81, which is directed to a polynucleotide comprising nucleotides -921 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is exemplified in the specification, at page 63 lines 9-10 and in Figure 7 (reply page 7).

The Examiner maintains that a polynucleotide comprising nucleotides -921 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is not exemplified in the specification at page 63 lines 9-10 and in Figure 7, or elsewhere in the specification. The Examiner notes, however, the exemplification at page 63 lines 9-10 and in Figure 7 of a promoter control element comprising nucleotides -913 to -767 as displayed in Figure 2, whose ability to function as a promoter control element is exemplified. It is suggested that claim 81 be amended to correspond to the promoter control element comprising nucleotides -913 to -767 as displayed in Figure 2, with reference to the appropriate sequence identifier as indicated in the above objection to claim 81, in order to obviate the rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Remarks***

No claim is allowed.

Claims 78 and 81-92 are deemed free of the prior art, given the failure of the prior art to teach or suggest an isolated nucleic acid of SEQ ID NO:1 or a host cell transformed therewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210.

The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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CC  
August 11, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180/1638  
